

## REMARKS

This Response is submitted in reply to the final Office Action mailed on October 16, 2006. No fee is due in connection with this Response. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-36 on the account statement.

Claims 1-16 are pending in this application. In the Office Action, Claims 1-2 and 6 are rejected under 35 U.S.C. §102. Claims 1-16 are rejected under 35 U.S.C. §103. For the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1-2 and 6 are rejected under 35 U.S.C. §102(b) as anticipated by the product 100% Whey Protein 5 lbs by Optimum Nutrition (“*Optimum Nutrition*”). Applicants respectfully disagree with and traverse this rejection for at least the reasons set forth below.

Applicants respectfully submit that the Patent Office has failed to demonstrate that *Optimum Nutrition* was on sale before the priority date of the present application. Moreover, the Patent Office has also failed to show that any earlier version of *Optimum Nutrition* (e.g., the product featured in Costello’s and cited by the Patent Office in the supplemental Office Action dated May 8, 2006) is identical to the *Optimum Nutrition* being relied upon in the current Office Action dated October 16, 2006. In fact, the whey protein product being relied upon in the current Office Action states that the formulation is “better than ever,” which suggests that the formulation has been modified from an earlier version. Furthermore, the website for *Optimum Nutrition* currently discloses that the most recent formulation of the whey protein product is the *third* generation of *Optimum Nutrition* whey protein products. See, Exhibit A. If, for example, the whey protein product being relied upon in the current Office Action is, in fact, the *second* version of the *Optimum Nutrition* whey protein product, the Patent Office has failed to demonstrate that this version is the same formulation as the product featured in Costello’s and that *Optimum Nutrition* was on sale before the priority date of the present application. Therefore, Applicants respectfully submit that the burden remains with the Patent Office to demonstrate that the *Optimum Nutrition* product formulation cited against the pending

application is, in fact, the same *Optimum Nutrition* product formulation cited by the Patent Office to establish a prior art priority date in the supplemental Office Action dated May 8, 2006.

Accordingly, Applicants respectfully request that the rejection of Claims 1-2 and 6 under 35 U.S.C. §102(b) be withdrawn.

In the Office Action, Claims 1-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Optimum Nutrition* in view of U.S. Patent No. 5,849,335 to Ballevre et al. ("*Ballevre*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

First, once again Applicants submit that the Patent Office has not demonstrated that *Optimum Nutrition* is proper prior art. Regardless, Applicants submit that one having ordinary skill in the art would not be motivated to combine *Optimum Nutrition* and *Ballevre* to arrive at the present claims. The whole premise of *Ballevre* is that carob protein is rich in glutamine and that its nutritional composition for improving plasma glutamine should include carob protein. *Ballevre* further teaches that its mixture of carob and whey proteins uses whey protein as the minor rather than the major component. See, *Ballevre*, column 4, lines 27-35; Example 2. For example, *Ballevre* discloses that carob protein comprises about 40% to about 100% by weight of the protein source of its nutritional composition, which results in the protein source in *Ballevre* containing a minimum of "about 40%" of the protein source of carob. Because *Ballevre* teaches that it is essential to retain carob protein, it teaches away from a combination with *Optimum Nutrition* that is directed to a product comprising 100% whey proteins.

Moreover, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998) (quoting *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994)). Therefore,

because *Ballevre* teaches away from a combination with *Optimum Nutrition*, Applicants respectfully submit that it is improper to combine the two references.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). This certainly applies here where one of the cited references is directed to a product that must comprise some and preferably a majority of carob protein (*Ballevre*) and the other cited reference is directed to a product comprising only whey protein (*Optimum Nutrition*). The specific formulation for each product as taught by the cited references is important and specific to that particular product. Because of these differences, one skilled in the art would not be motivated to modify or combine *Optimum Nutrition* and *Ballevre* to arrive at the present claims.

For at least the reasons discussed above, the combination of *Optimum Nutrition* in view of *Ballevre* is improper, and thus, fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1-16 be reconsidered and the rejection be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Robert M. Barrett  
Reg. No. 30,142  
Customer No. 29157

Dated: January 3, 2007

# Exhibit A



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## Optimum 100% Whey Protein

**2 Lbs. ~~\$23.00~~ \$13.98**  
Extreme Milk Chocolate:  
[Order]

French Vanilla Creme:  
[Order]

Gold Standard  
Chocolate: [Order]

Gold Standard  
Chocolate Mint: [Order]  
Gold Standard Cookies  
N' Cream: [Order]

Gold Standard Rocky  
Road: [Order]  
Gold Standard  
Strawberry: [Order]

Gold Standard Tropical  
Punch: [Order]  
Gold Standard Vanilla:  
[Order]

**5 Lbs. ~~\$43.00~~ \$28.89**  
Extreme Milk Chocolate:  
[Order]

French Vanilla Creme:  
[Order]

Gold Standard  
Chocolate: [Order]

Gold Standard  
Chocolate Mint: [Order]  
Gold Standard Cookies  
N' Cream: [Order]

Gold Standard Rocky  
Road: [Order]  
Gold Standard  
Strawberry: [Order]

Gold Standard Tropical  
Punch: [Order]  
Gold Standard Vanilla:  
[Order]

Gold Standard  
Chocolate: [Order]  
Gold Standard Rocky  
Road: [Order]  
Gold Standard  
Strawberry: [Order]

**10 Lbs. ~~\$79.00~~ \$55.79**  
Gold Standard  
Chocolate: [Order]  
Gold Standard Rocky  
Road: [Order]  
Gold Standard  
Strawberry: [Order]  
Gold Standard Vanilla:

Optimum Presents:  
**100% Whey  
Protein**  
With Faster-Acting  
HYDROWHEY!



### Other Products

This works well with:

>[Chitosan Plus](#)  
>[Xylitol](#)  
>[Lean Elite](#)  
>[Mega L-Carnitine](#)

### Whey Protein Isolates As The Primary Protein Source!

**Note:** Optimum has made a slight change to the formula of 100% Whey Protein to make it an even better protein powder. The name is changing also to be "100% Whey Gold Standard". The price will remain the same though!

\*Try the Extreme Milk Chocolate and French Vanilla Creme. These are Optimum's new Limited Edition Flavors.

**Optimum 100% Whey Protein won the Supplement Of The Year and Protein Powder Of The Year award for 2005 and 2006!** Since the very beginning, Optimum Nutrition has raised the standard by which all other whey protein supplements are judged. Now we're raising the bar again with the 3rd generation of ON 100% Whey Protein: ON 100% Whey Gold Standard.



**Supplement Of The Year**  
[ [More Info](#) ]

**Protein Powder Of The Year**  
[ [More Info](#) ]

Like its predecessors, this canister of ON 100% Whey Gold Standard contains Optimum Nutrition's exclusive, proprietary blend of...

- Microfiltered Whey Protein Isolates
- Ion-Exchange Whey Protein Isolates
- Ultrafiltered Whey Protein Concentrate
- HydroWhey Hydrolyzed Whey Peptides

To give you more of what you want (pure, unadulterated whey protein) with less of what you don't (fat, saturated fat, cholesterol, lactose, and other carbohydrates) with every serving. This whey protein supplement is no exception. In fact, ON 100% Whey Gold Standard is better than ever! Here's why:

1. ON 100% Whey Gold Standard provides more whey protein isolates

[\[Order\]](#)[Other Optimum Products](#)[About Optimum](#)**What's In It?**  
**Supplement Facts:**

Container Size: 2 Lbs.  
Serving Size: 1 Scoop  
Servings Per Container: 31

Container Size: 5 Lbs.  
Serving Size: 1 Scoop  
Servings Per Container: 74

Container Size: 10 Lbs.  
Serving Size: 1 Scoop  
Servings Per Container: 155

**Amount Per Serving:**

Calories: 120  
-Calories from Fat: 10  
Total Fat: 1g  
-Saturated Fat: 0.5g  
Cholesterol: 30mg  
Total Carbohydrates: 3g  
-Sugars: 1g  
Protein: 24g  
Calcium: 140mg  
Sodium: 60mg  
Potassium: 220mg  
Enzyme Blend: 25mg  
-Aminogen --  
-Lactase --

**Other Ingredients:**  
Protein blend (whey protein isolate, whey protein concentrate, whey peptides), cocoa (processed with alkali), artificial flavor, lecithin, acesulfame potassium.

**Note:** Nutritional content and ingredients may vary slightly between flavors.

**Directions:** To encourage a positive nitrogen balance, consume approximately 1 gram of protein per pound of body weight per day from a combination of high protein foods and supplements. For even better results, consume your daily protein allotment over 4-6 small meals spread evenly throughout the day.

\*Try the Extreme Milk Chocolate and French Vanilla Creme. These are Optimum's new Limited

(WPI) - the purest and most expensive source of whey protein available.

- Higher protein percentage. ON's 100% Whey Gold Standard has always been a leader in this respect. Now with 24 grams of protein in just slightly over one-ounce serving, it's nearly 79% protein by weight!
- We've included more HydroWhey strategically hydrolyzed, low molecular weight whey peptides to make ON's 100% Whey Gold Standard even faster acting!
- ON's 100% Whey Gold Standard now contains lactase and Aminogen digestive enzymes to further enhance absorption and make this product even more friendly to lactose intolerant individuals.
- ON's 100% Whey Gold Standard is instantized to mix easily and completely with just a few twirls of a spoon.
- Every serving supplies even more low, moderate, and high molecular weight, biologically active whey protein microfractions including Alpha-lactalbumin, Glycomacropeptides, Beta-lactoglobulin, Immunoglobulin G (IgG), Lactoferrin, lactoperoxidase, and various growth factors.
- Over 4 grams of glutamine and glutamine precursors as well as 5 grams of BCAAs (leucine, isoleucine, and valine) in each scoop!

**Order today using our 100% secure server and get it at the lowest prices in the world with our fast, inexpensive 2 - 3 day shipping! NOBODY beats our overall price!**

**2 Lbs. ~~\$23.00~~ \$13.98**

Extreme Milk Chocolate: [\[Order\]](#)  
French Vanilla Creme: [\[Order\]](#)  
Gold Standard Chocolate: [\[Order\]](#)  
Gold Standard Chocolate Mint: [\[Order\]](#)  
Gold Standard Cookies N' Cream: [\[Order\]](#)  
Gold Standard Rocky Road: [\[Order\]](#)  
Gold Standard Strawberry: [\[Order\]](#)  
Gold Standard Tropical Punch: [\[Order\]](#)  
Gold Standard Vanilla: [\[Order\]](#)

**5 Lbs. ~~\$43.00~~ \$28.89**

Extreme Milk Chocolate: [\[Order\]](#)  
French Vanilla Creme: [\[Order\]](#)  
Gold Standard Chocolate: [\[Order\]](#)  
Gold Standard Chocolate Mint: [\[Order\]](#)  
Gold Standard Cookies N' Cream: [\[Order\]](#)  
Gold Standard Rocky Road: [\[Order\]](#)  
Gold Standard Strawberry: [\[Order\]](#)  
Gold Standard Tropical Punch: [\[Order\]](#)  
Gold Standard Vanilla: [\[Order\]](#)

**10 Lbs. ~~\$79.00~~ \$55.79**

Gold Standard Chocolate: [\[Order\]](#)  
Gold Standard Rocky Road: [\[Order\]](#)  
Gold Standard Strawberry: [\[Order\]](#)

Edition Flavors.

Warnings: This product contains whey derived from dairy and lecithin (to improve mixability) derived from soybeans. For use as a dietary supplement only. Do not use for weight reduction.

*These statements have not been evaluated by the Food and Drug Administration. This product is not intended to diagnose, treat, cure, or prevent any disease.*

Gold Standard Vanilla: [\[Order\]](#)

**[Learn more about Whey Protein.](#)**

**[Check out other Fat Loss Products.](#)**

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Bodybuilding.com, 305 Steelhead Way, Boise, ID 83704, 1-877-991-3411

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